

Claims 16-37 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 16 February 2010.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsien et al. in view of McWherter et al. for reasons of record set forth in the previous Office Action.

At the first paragraph at page 3 of the remarks filed 29 March 2011, Applicants argue that there needs to be a suggestion or motivation to combine the prior art teachings and apply the rejection. Applicants point to MPEP §§2142 and 2143 in support of this, arguing that the court stated that “[t]here are three possible sources for a motivation to combine references: the nature

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of the problem to be solved, the teachings of the prior art, and the knowledge of persons skilled in the art.” However, in the cited sections of the MPEP, there is discussion of KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1395-97 (2007). It is clear from KSR that teaching, suggestion or motivation is only one of a number of rationales for combining teachings in support of a rejection under 35 USC §103(a). The rationale given in the previous Office Action complies with KSR. In the subsequent paragraph, Applicants argue that the molecules taught by McWherter are not modulatable proteins, but rather are bi-functional molecules where binding of one ligand does not influence binding of the other. However, in the paragraph bridging the left- and right-hand columns at page 4569, McWherter et al. teaches that binding of the IL-3R domain stabilized or enhanced the cpG-CSF domain. Thus, one of ordinary skill in the art would have recognized that the fusion protein of McWherter et al. would have been a useable substitute in the methods of Tsien et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK

1 June 2011

/James S. Ketter/

Primary Examiner, Art Unit 1636